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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,808	12/19/2001	Thomas D. Meek	P51217	6102

7590 06/09/2003

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EXAMINER

DUFFY, PATRICIA ANN

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 06/09/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/024,808

Applicant(s)
Meek et al

Examiner
Patricia A. Duffy

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1645



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-17 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

1. Prior to setting forth the restriction requirement, it is noted out that the claims ¹⁻¹⁷ recite improper Markush Groups. M.P.E.P. 803.02 states that: Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978); and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, *unless the subject matter in a claim lacks unity of invention* [emphasis added], *In re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility and (2) share a substantial structural feature disclosed as being essential to that utility." In the instant case, the method and products rely upon opposite and mutually exclusive activities (i.e. inhibition versus activation) and therefore, require non-coextensive searches to such an extent that they are considered not to share a functional and structural feature in common.

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Election/Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claim 1 (in part), drawn to an antagonists that inhibits the activity of SEQ ID NO:2, classified in class 530, subclass 300.
 - II. Claim 1 (in part), drawn to an agonist that activates that activity of SEQ ID NO:2, classified in class 536, subclass 26.24.
 - III. Claims 2-8 and 11-17 (in part) , drawn to methods of use of the antagonists to inhibit FabG (SEQ ID NO:2), classified in class 514, subclass 2.
 - IV. Claims 2-8 and 11-17 (in part) , drawn to methods of use of the agonists to activate FabG (SEQ ID NO:2), classified in class 514, subclass 52
 - V. Claim 9 (in part), drawn to an antagonists that inhibits the activity of SEQ ID NO:1, classified in class 536, subclass 24.5.
 - VI. Claim 9 (in part), drawn to an agonist that activates that activity of SEQ ID NO:1, classified in class 536, subclass 23.2.
 - VII. Claim 10 (in part) , drawn to methods of use of the antagonists to inhibit SEQ ID NO:1, classified in class 514, subclass 44.
 - VIII. Claim 10 (in part) , drawn to methods of use of the agonists to activate SEQ ID NO:1, classified in class 514, subclass 44.

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3. Inventions (I or II) and (III or IV) respectively are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product may be used to label the enzyme or purify the enzyme by affinity chromatography.

4. Inventions (V or VI) and (VII or VIII) respectively are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product may be used to label the enzyme or purify the enzyme by affinity chromatography. It is further noted that the claims recite that SEQ ID NO:1 is a polypeptide, however both the sequence listing and the specification describe SEQ ID NO:1 as a polynucleotide. If applicants elect any of inventions V-VIII they are requested to clarify this issue. For purposes of this restriction, these claims have been interpreted as nucleic acid inhibitors and activators.

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5. Inventions (I or V) and (II or VI) are related as products. The products are distinct as claimed because they have the opposite activities (inhibits versus activates).
6. Inventions I and V are related as products. The products are distinct as claimed because the product of invention I inhibits a polypeptide (FabG, SEQ ID NO:2) whereas the product of invention V inhibits a nucleic acid sequence (SEQ ID NO:1).
7. Inventions II and VI are related as products. The products are distinct as claimed because the product of invention I activates a polypeptide (FabG, SEQ ID NO:2) whereas the product of invention V activates a nucleic acid sequence (SEQ ID NO:1).
8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
9. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
10. This application contains claims directed to the following patentably distinct species of the claimed invention:

Each of the individual Markush members in claims 1-17, list in the alternative 16 different target activities that form 16 discrete species, the target activities appear

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mutually exclusive and non-overlapping in nature. Applicants are required to select a single activity (specie) for prosecution on the merits.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In

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either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

11. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

12. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

13. Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1600 is (703) 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia A. Duffy, Ph.D. whose telephone number is (703) 305-7555. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached at (703) 308-3909.


Patricia A. Duffy, Ph.D.

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June 8, 2003


Patricia A. Duffy, Ph.D.
Primary Examiner
Group 1600